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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/994,011

11/06/2001

Depeng Bi

11748/25

8815

7590

09/26/2006

KATTEN MUCHIN ZAVIS

Attention: Patent Administrator

Suite 1600

525 West Monroe Street

Chicago, IL 60661-3693

EXAMINER

CHOWDHURY, SUMAIYA A

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/994,011	BI ET AL.	
	Examiner	Art Unit	
	Sumaiya A. Chowdhury	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/30/06 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee (6130726) in view of Moroney (6532593).

As for claim 1, Darbee teaches a system for controlling playback of digital content,

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the system comprising:

a computing platform (set-top box) which communicates with a remote playback device (TV display);

a digital content player application (program guide) resident on said computing platform for enabling playback of said digital content on said remote playback device; [The program guide is delivered to the set-top box where it is stored. The program guide allows the user to select programs to view. – col. 8, lines 60-67] and

a remote control device (12 – Fig. 1) which includes a communication system (RF or IR link) for communicating with said computing platform over a predetermined communication link (wireless link; col. 9, lines 7-20), said remote control device further including a display (14 – Fig. 1) for displaying a list of available digital content (television programs), said remote device further including a input device (remote keys) to enable digital content to be selected from the available digital content and a control system for displaying said available digital content and causing the selected digital content to be played on said remote playback device (Program guide is displayed on the remote control screen, from which the user can select a program to view on the television screen – col. 11, lines 6-11, col. 13, lines 14-14).

However, Darbee fails to teach the following:

The computing platform includes playback hardware for storing digital content;

In an analogous art, Moroney teaches the set-top terminal includes a hard drive (playback hardware) for storing television programs (digital content) in order to integrate

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the function of a VCR into a set-top terminal, thereby reducing the overall cost of purchasing separate equipment to the user – col. 3, lines 21-28.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Darbee's invention to include the above mentioned limitation, as taught by Moroney, for the advantage of integrating the function of a VCR into a set-top terminal, thereby reducing the overall cost of purchasing separate equipment to the user.

As for claim 2, Darbee and Moroney disclose the claimed limitations. In particular, Darbee discloses wherein the system includes a transmitter for transmitting from said computing platform (STB) to a remote analog playback device (TV display) – (There is clearly some type of communication (ex. Coaxial cable) between the STB and television since the user selects what to view on the television. - col. 11, lines 6-11, col. 13, lines 14-14).

As for claims 3 & 4, Darbee and Moroney disclose the claimed limitations. In particular, Moroney discloses wherein the digital content is digital audio and video data (Digital programming services such as television programs is inclusive of digital audio and digital video – col. 3, lines 21-25)

As for claims 5 & 9, Darbee and Moroney disclose the claimed limitations. In particular, Moroney discloses the memory is a hard drive - col. 3, lines 21-28.

As for claims 6 & 7, Darbee and Moroney disclose the claimed limitations. In particular, Darbee discloses wherein the terminal receives the digital content over an Internet network – (Provides internet content display; therefore, the internet is used to retrieve content – col. 7, lines 50-52)

As for claim 8, Darbee and Moroney disclose the claimed limitations. In particular, Darbee discloses wherein the user interacts with the computing platform by inputting commands into the remote control which are outputted by the remote control and transmitted to the STB – col. 9, lines 7-20.

As for claim 10, Darbee and Moroney disclose the claimed limitations. In particular, Moroney discloses a removable storage device – col. 7, lines 5-10.

As for claims 11-13, Darbee and Moroney disclose the claimed limitations. In particular, Darbee discloses wherein the remote control communicates with the computer over an RF or infrared wireless link (col. 9, lines 7-20).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumaiya A. Chowdhury whose telephone number is (571) 272-8567. The examiner can normally be reached on Mon-Fri, 9-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAC



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